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Remarks

Claims 1, and 13 are currently amended.

Claims 17-18 are newly added.

Claims 1-7 and 13-16 are rejected.

Claims 1-7 and 8-18 are pending herein.

This request is in response to the Examiner's Answer mailed 12-09-2008 based on an appeal brief filed 10-21-2007 appealing from a final Office action mailed 05/13/2003 (05-13-2003 OA).

The request under 37 CFR §1.111 to reopen prosecution is based on the New Grounds of Rejection recited by Examiner on pages 8-9 of the 12-09-08 Examiner's Answer (hereinafter "12-09-08 Answer") under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Prosecution should be reopened as specified under MPEP 1207.03:

37 CFR 41.39(b) provides that: if an examiner's answer contains a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title.

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Thus, entry of this request is respectfully requested. MPEP 1207.04 "Reopening of Prosecution After Appeal The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. ...Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits."

EXAMINER'S ANSWER AND 5-13-2008 OA

In the Examiner's Answer of December 09, 2008 (hereinafter "12-09-2008" Examiner's Answer) referenced above, the Examiner:

rejected Claims 1-7 and 13-16 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter;

rejected claims 13-16 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor (s), at the time the application was filed, had possession of the claimed invention;

rejected Claims 1-5 and 13-16 under 35 USC § 103(a) as being anticipated by JOHNSON U.S. Patent No. 6,023,683

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(hereinafter "JOHNSON") in view of Jolliffe et. al U.S. Patent No. 5,646,862 (hereinafter "JOLLIFFE"); and

rejected Claims 6-7 under 35 U.S.C. §103(a) as being obvious over JOHNSON/ JOLLIFFE combination in further view of Danneels et. al. U.S. Patent No. 6,272,472 B1 (hereinafter "DANNEELS").

Additionally, the 12-09-2008 Examiner's Answer was silent as to the following issues that were presented in the 5-13-2003 OA, wherein the Examiner:

rejected Claims 1-7 under 35 U.S.C. §112, 1st Paragraph, as failing to clearly define subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention; and

rejected Claims 1-7, and 13-16 under 35 U.S.C. §112, 2nd Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;

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New Grounds of Claim Rejections Under
35 USC § 101

Claims 1-7 and 13-16 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Examiner stated in the 12-09-2008 Answer, pages 8-9 as follows:

Based on Supreme Court precedent and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (*en banc*).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

"To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject-matter that is being transformed.

Here, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. Independent claim 1 merely recites identifying, creating, a product, searching, identifying, causing, transmitting, selectively, purchasing - none of which are tied to a statutory class of matter, or involve a transformation of subject matter to a different state or thing. Independent claim 13 merely recites fixing, decomposing, identifying, creating a template, and searching. -none of which are tied to a statutory class

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of matter, or involve a transformation of subject matter to a different state or thing."

Applicant respectfully traverse Examiner's rejection of Claims 1-7 and 13-16 under 35 U.S.C. §101.

Claims 1 and 13 were amended to include: **"providing a communications network having a computer including at least one purchaser and a plurality of suppliers that are each physically and communicatively coupled to the communications network."**

Support for amending claim 1 is disclosed on page 8, lines 18-26 through page 9, lines 1-3:

To better understand the operation of the methodology 10 reference is now made to the computer architecture configuration 30 of Figure 3 which requires the purchasing business organization to have a computer 32 which is communicatively and physically coupled to a global communication network 34 such as the Internet. Each prospective supplier, such as suppliers 36 and 38 are also physically and communicatively coupled to the communications network 34, effective to allow the query which is required by step 20 to be dynamically and automatically accomplished by computer 12 through the use of communications network 34.

Additionally claim 1 was amended to include the limitation: **"creating an information template that is queried and dynamically configurable on the computer within the communications network for each of the plurality of suppliers wherein each of the information template specifies a**

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product having at least one component disposed within the product"

Similarly, claim 13 was amended to include the limitation: creating an information template having a dynamically configurable and searchable field that is queried on the computer within the communications network".

Support for amending claims 1 and 13 to include the queried and dynamically configurable information template is disclosed in Applicant's Application page 4, lines 1-9; page 7, lines 10-14, 25-26 through page 8, lines 1-2; page 8, lines 18-26 through page 9, lines 1-21.

Additionally, claim 1 is amended to include the limitation "searching each of the information templates selectively stored within a single database for the specified at least one component disposed within each product" and "causing a design file of said product to be created within the communications network".

Further support for amending claim 1 to include searching each of the information templates selectively stored within a single database is disclosed in Applicant's Application, page 10, lines 1-7, 14-16: "These files may also selectively be used to construct a three dimensional prototype Step 62 . . . each

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template 50 may be selectively stored within a single database
Step 64."

Support for amending claim 1 to include causing a design
file of said product to be created within the communications
network is disclosed in Applicant's Application, page 4,
lines 1-9, 23-26 through page 5, lines 1-8:

It is a fifth object of the present invention to
provide a method for designing and purchasing a
product with allows potential sources of the product
to be easily and quickly identified by use of a
computerized analysis system ... creating a database
containing the identity of a first and a second
supplier for the at least one component; querying
the database, effective to identify a first supplier
and a second supplier of the at least one
component; contacting each of the first and second
supplier by use of a global communications network
to request a computer aided design file from each
supplier describing the respective at least one
component provided by the first and second
suppliers; receiving the computer aided design file;
and using the computer aided design file to evaluate
the at least one component respectively provided by
the first and second suppliers.

In the case In re Bilinski, 545 F.3d 943, 88 U.S.P.Q.2d
1385 (Fed. Cir. 2008), the court determined

"The machine-or-transformation test is a two-
branched inquiry; an applicant may show that a
process claim satisfies § 101 either by showing that
his claim is tied to a particular machine, or by
showing that his claim transforms an article.
Certain considerations are applicable to analysis
under either branch. First, as illustrated by Benson
and discussed below, the use of a specific machine
or transformation of an article must impose
meaningful limits on the claim's scope to impart
patent-eligibility. Second, the involvement of the
machine or transformation in the claimed process

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must not merely be insignificant extra-solution activity. Id. at 961-962 (citations omitted, emphasis added).

"As to machine implementation, Applicants themselves admit that the language of claim 1 does not limit any process step to any specific machine or apparatus. See Appellants' Br. at 11. As a result, issues specific to the machine implementation part of the test are not before us today. We leave to future cases the elaboration of the precise contours of machine implementation, as well as the answers to particular questions, such as whether or when recitation of a computer suffices to tie a process claim to a particular machine." Id. at 961-962 (citations omitted, emphasis added).

"We will, however, consider some of our past cases to gain insight into the transformation part of the test. A claimed process is patent-eligible if it transforms an article into a different state or thing. This transformation must be central to the purpose of the claimed process. But the main aspect of the transformation test that requires clarification here is what sorts of things constitute "articles" such that their transformation is sufficient to impart patent-eligibility under § 101. It is virtually self-evident that a process for a chemical or physical transformation of physical objects or substances is patent-eligible subject matter. . . . Thus, claim 1 does not involve the transformation of any physical object or substance, or an electronic signal representative of any physical object or substance. Given its admitted failure to meet the machine implementation part of the test as well, the claim entirely fails the machine-or-transformation test and is not drawn to patent-eligible subject matter." Id. at 963-964.

Amended claims 1 and 13 of Applicant's Application, unlike the Appellants' Application in Bilinski, recite use of a communications network having a computer including at least one purchaser and a plurality of suppliers that are each physically and communicatively coupled to the communications

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network; and creating an information template that is queried and dynamically configurable on the computer within the communications network use of a computer on a computer network to tie the process of a method for purchasing a product to the communications network.

The information template is configurable to represent a component or products from an associated supplier and is stored within a database of a computer, thus the template can be configured/"modified" in the form of an electronic signal representative of one or more components or products.

Regarding claim 1, in addition to providing a communications network having a computer, claim 1 is further directed to searching each of the information templates selectively stored within a database for the specified at least one component disposed within the product; and

causing a design file of said product to be created within the communications network.

Thus, the machine that is tied to the process of a method for purchasing a product is a communications network having a computer and wherein the computer has a template stored in a database with the computer that is dynamically configurable, i.e. transformative to search a product or component stored therewithin and to ultimately cause a design file of said

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product to be created within the communications network to form a 3-dimensional prototype of the product.

Additionally claim 13 further recites "wherein the dynamically configurable and searchable field is configured on the computer to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of said product associated with each of said plurality of suppliers and wherein the interrelationship attributes of said components further define the overall function of each of the several interconnected components."

With regard to claim 13, the use of a specific computer on a computer network or the transformation of the dynamically configurable and searchable field on the computer imposes meaningful limits on the claim's scope to impart patent-eligibility by specifying a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of said product associated with each of said plurality of suppliers. Secondly, the involvement of the machine or transformation (computer on a computer network) in the claimed process of purchasing a product is not merely be insignificant extra-solution activity because without use of the computer, the template having the configurable and searchable field of the template could not be accessed and

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would not be functional to be used to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of said product.

Thus, unlike the invention of the Appellant's in Bilinski that was directed to a purely financial method of hedging risk in field of commodities trading without use of a specific machine, Applicant's invention is directed to computer on a communications network having a dynamically configurable template representative of products or components that is modified to create a three dimensional prototype or to further define interrelational attributes of interconnected products or components, thereby tying the network having the computer to the method of purchasing a product to define patentable subject matter under 35 USC §101.

It is believed that Applicant's Invention as claimed in claims 1 and 13, and claims 2-7, and 13-18, which respectively depend therefrom is now directed to statutory patentable subject matter under 35 USC §101.

Applicant respectfully requests that the rejection under 35 USC §101 is obviated and should be removed and that the claims 1-7, and 13-18 be reconsidered as being directed to statutory subject matter under 35 USC §101.

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Claim Rejections Under
35 U.S.C. § 112 1st Paragraph

Claims 13-16 are rejected under 35 U.S.C. §112 1st as failing to clearly define subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

In the 12-09-2008 Examiner's Answer, page 4, claim 13 was rejected based on the consideration that the phrase "creating an information template having a dynamically configurable and searchable field . . ." contains new matter.

Accordingly, Claim 13 has been amended as required under 35 USC § 112 1st paragraph to obviate Examiner's rejection of 13 under 35 USC § 112 1st Paragraph.

Applicant traverses the Examiner's new matter rejection under 35 U.S.C. §112 1st Paragraph based on the amended claim 13.

Claim 13 has been amended to clearly define the step of

"creating an information template having a dynamically configurable and searchable field that is queried on the computer within the communications network, wherein the dynamically configurable and

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searchable field is configured on the computer to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of said product associated with each of said plurality of suppliers and wherein the interrelationship attributes of said components further define the overall function of each of the several interconnected components".

There is support for Amended claim 13 is disclosed in the original specification and thus, the basic limitation "creating an information template having a dynamically configurable and searchable field wherein the dynamically configurable and searchable field that is queried on the computer within the communications network" does not contain new matter.

Support for Amended claim 13 is disclosed in the original specification, page 7, lines 10-14, 25-26 through page 8, lines 1-2; page 8, lines 18-26 through page 9, lines 1-21:

a computer 32 which is communicatively and physically coupled to a global communication network 34 such as the Internet. Each prospective supplier, such as suppliers 36 and 38 are also physically and communicatively coupled to the communications network 34, effective to allow the query which is required by step 20 to be dynamically and automatically accomplished by computer 12 through the use of communications network 34. . . . In order to allow the data or information to be efficiently categorized and acquired, each supplier 36, 38 is required to have a template such as template 50 in Figure 2. Particularly, template 50 includes a first dynamically configurable and searchable field 52 which identifies an item (i.e. a final assembly or component). Template 50 further includes a dynamically configurable and searchable field 54 which specifies the physical attributes of the item

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and a dynamically configurable and searchable field 56 which specifies the attributes related to the interrelationship of this item to other items or components. An intangible field 57 is also used to specify the cost, availability, and other intangible attributes. These templates 50 are created for each component, product or final assembly which is produced by each respective supplier 36, 38 Step 29 and are dynamically updated to allow modifications and changes to be made to the products and to reflect the creation of new products and components."

The 12-09-2008 Examiner's Answer was silent as to the rejection of claims 1-7 under 35 UCS 112 1st paragraph originally rejected by Examiner on page 4 of the 5-13-2003 OA. The rejection of claims 1-7 under 35 UCS 112 1st paragraph was based on the uncertainty of "how "purchasing said product from said at least one identified supplier" occurs since this would make irrelevant the earlier claimed distinction of searching for components from particular suppliers."

Claim 1 has been amended to clearly define the step of "creating an information template that is queried and dynamically configurable on the computer within the communications network for each of the plurality of suppliers wherein each of the information template specifies a product **having at least one component** disposed within the product".

Support for Amended claim 1 is disclosed in the original specification, page 7, lines 25-26 through page 8, lines 1-2;

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page 8, lines 18-26 through page 9, lines 1-21 (See support for Amending claim 13, supra):

a computer 32 which is communicatively and physically coupled to a global communication network 34 such as the Internet. Each prospective supplier, such as suppliers 36 and 38 are also physically and communicatively coupled to the communications network 34, effective to allow the query which is required by step 20 to be dynamically and automatically accomplished by computer 12 through the use of communications network 34. . . . Particularly, template 50 includes a first dynamically configurable and searchable field 52 which identifies an item (i.e. a final assembly or component). Template 50 further includes a dynamically configurable and searchable field 54 which specifies the physical attributes of the item and a dynamically configurable and searchable field 56 which specifies the attributes related to the interrelationship of this item to other items or components

In the 12-09-2008, Examiner's Answer, page 8, the

"Examiner notes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked, Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. 1.111 (b) (i.e. Applicants have not argued lexicography is invoked). To further support the Examiner's position that Applicants are not their own lexicographer, it is the Examiner's factual determination that not only have Applicants failed to point to definitional statements in their specification or prosecution history, Applicants have also failed to point to a term or terms of a claim with which to draw in those statements; Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer. Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless

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expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and customary meaning is not overcome, the claims therefore continue to be interpreted with their broadest reasonable interpretation standard."

Applicant traverses Examiner's assertion that Applicants have decided not to be their own lexicographer and also traverses Examiner's interpretation of the claims in view a broadest reasonable interpretation standard as being improper.

The proper standard for claim interpretation is **based on giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art" as discussed in Phillips v. AWH Corp., 415 F.3d 1303, 1316 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005):**

"Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent. Furthermore, like the specification, the prosecution history was created by the patentee in attempting to explain and obtain the patent. Yet because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, **it often lacks the clarity of the specification and thus is less useful for claim construction purposes.** See *Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1380-82 (Fed.Cir.2002) (the ambiguity of the prosecution history made it less relevant to claim construction); *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1580 (Fed.Cir.1996) (the ambiguity of the prosecution history made it "unhelpful as an interpretive resource" for claim construction)." *Id.* at 1317 (citations omitted, emphasis added).

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Thus, contrary to assertion of Examiner requiring the Applicant to explicitly invoke lexicography to interpret the claims using a different standard than the broadest reasonable interpretation standard may "lack [sic] the clarity of the specification and thus [may be] less useful for claim construction purpose[s]."

The standard for interpretation of Applicant's Claims should be based on the standard dictated by Phillips:

"The pertinence of the specification to claim construction is reinforced by the manner in which a patent is issued. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description." Id at 1316 (citations omitted, emphasis added). "[T]he meaning of the terms in the claims may be ascertainable by reference to the description." 37 C.F.R. § 1.75(d)(1). It is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." Id at 1317 (citations omitted, emphasis added).

"Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Id at 1313 (citations omitted, emphasis added). "It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor's words that are used to describe the invention-the inventor's lexicography-must be understood and interpreted by the court as they would be understood and interpreted by a person in

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that field of technology. Thus the court starts the decisionmaking process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history." Id at 1314 (citations omitted, emphasis added). "The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." As we stated in *Vitronics*, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." Id at 1315 (citations omitted, emphasis added).

"[T]he descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims." Id at 1315 (citations omitted, emphasis added).

Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs. Id at 1316 (citations omitted, emphasis added).

Thus, the proper standard for claim interpretation throughout prosecution of this application is reading the claims in view of the specification as the single best guide to the meaning of a disputed term. Requiring that additionally, Applicant explicitly invoke lexicography or forever lose the right to interpret the claims is improper and is contrary to the teachings of *Phillips*. Particularly, with respect to interpretation of claims amended since the 5-13-08 OA, preventing Applicant from being Applicant's s own

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lexicography and basing claim interpretation on Examiner's own reasonable interpretation standard circumvents the teachings not only of Phillips but also in granting due process to Applicant in negotiating with the Examiner interpretation of Applicant's claims.

As such, a discussion of Applicant's the term "product" in light of the claims follows.

As applicant is entitled to be "his or her own lexicographer", see Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998), the term "product" as used within applicant's originally submitted application "means any tangible item which must be created or obtained and which meets certain needs or requirements of a business organization and/or certain customers of such a business organization." Applicant's Application, page 1, lines 23-27. See also, Applicant's Application, page 3, lines 15-22 "a method for designing and purchasing a product . . . which identifies potential sources of the product and/or of components which may be assembled to produce such a product while technically and economically evaluating each of the potentially sourced products and component combinations."

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Thus, a product having only one component allows a single component to be a product. Additionally, if each product has at least one component, then a search of each of the information templates for each supplier would necessarily search the product and the at least one component disposed within the product. Likewise, a search of each of the information templates would necessarily search a product and each component within a product if the product had more than one component (see newly added claim 18, that defines a product as having a plurality of components).

In light of amendments to Claims 1 and 13, Examiner's rejections under 35 U.S.C. 112 1st paragraph have been obviated and thus, Applicant requests that the rejection of claims 1-7 and 13-16 be removed.

Claim Rejections Under 35 U.S.C. §112 2nd Paragraph

Examiner's Answer was silent as to the 5-13-03 OA rejection of Claims 1-7 and 13-16 under 35 U.S.C. §112, 2nd Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1 and 13 have been amended as required under 35 USC § 112 2nd paragraph to obviate Examiner's previous rejection of Claims 1-7 and 1-13 under 35 USC § 112 2nd Paragraph.

Applicant traverses the Examiner's previous rejections under 35 U.S.C. §112 2nd Paragraph based on the amended claims 1 and 13.

In the 5-13-03 OA, page 4, clause 8a, claim 1 was rejected based on the uncertainty of whether "the computerized design file" is associated with the product or associated with a component.

Claim 1 was amended to further define the computerized design file. Claim 1 as amended clearly defines the steps of "searching each of the information templates selectively stored within a single database for the specified at least one component disposed within each product;

transmitting at least one computerized design file associated with **the at least one component** disposed within said product created from each of said identified suppliers from the plurality of suppliers to a purchaser, and

selectively using said at least one transmitted computerized design file **associated with the at least one component disposed within said product** to create a three dimensional prototype of said product; and purchasing said **at least one component disposed within the product** from said at least one identified supplier from the plurality of suppliers."

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Support for amending claim 1 to include searching, and purchasing, and the substeps transmitting and selectively using is disclosed in Applicant's Application. page 4, lines 23-26 through page 5, lines 1-8, as discussed supra.

Additional support for amending Claim 1 is disclosed in Applicant's Application, page 7, lines 10-14, 25-26 through page 8, lines 1-2; page 9, lines 3-21; and page 10, lines 1-7, 14-16 "computerized design files may be transmitted by the potential supplier 36, 38 to the purchaser 32 (Step 62), effective to allow the purchaser 32 to determine whether the sourced components and/or product meets the technical need of the organization (step 58). **These files may also selectively be used to construct a three dimensional prototype** Step 62 . . . each template 50 may be selectively stored within a single database Step 64."

As defined in the currently amended claim 1, the product has at least one component disposed within the product, and therefore, the computerized design file is associated with the component. Thus, the at least one component design file searched within the configurable template is used to create the 3-D prototype.

In the 5-13-03 OA, page 4, clause 8b, claim 1 was rejected based on the uncertainty of whether the step of purchasing said product from said at least one identified

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supplier" provides for each supplier to only supply a component. The examiner suggested that the last phrase be changed to "purchasing said component and not the product." Claim 1 has been amended in light of Examiner's suggestion.

In the 5-13-03 OA, page 5, clause 8c, claim 1 was rejected based on the uncertainty of whether the "searching" and "transmitting step was performed for just a single component or all components. Claim 1, as amended, associates the searching and transmitting step with the at least one component disposed within said product.

As mentioned supra, the at least one component is disposed within the product and when the product has only one component, the product is the component. If the product has a plurality of components, then each of the component design files would be searched and transmitted.

Additionally, in the 5-13-03 OA, page 5, clause 8d, claim 1 was rejected based on the uncertainty of whether the step of "causing a design file of said product to be created . . ." includes all three sub-steps of "transmitting," "using," and "purchasing".

Additionally, claim 1 as amended clearly defines the step of "causing a design filed of said product to be created has

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two sub-steps of "transmitting and selectively using" as denoted by the indentation of the transmitting and selectively using sub-steps underneath the "causing a design file of said product to be created" and the separation of the sub-steps from the step of "purchasing said at least one component disposed within the product" separated that is separated from the substeps via a semicolon. Thus, the step of "purchasing said at least one component . . ." is an ordinary step, and not a substep.

In the 5-13-03 OA, page 6, clause 8e, claim 13 was rejected based on the uncertainty of how the information template which corresponds to the particular suppliers is dynamically configurable. The information template is dynamically configurable as specified in currently amended claim 13 that clearly defines the information template to have "a dynamically configurable and searchable field that is queried on the computer within the communications network wherein the dynamically configurable and searchable field is configured on the computer to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of said product associated with each of said plurality of suppliers and wherein the interrelationship attributes of said components further define the overall function of each of the several interconnected components . . ."

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In light of amendments to Claims 1 and 13, Examiner's rejections under 35 U.S.C. 112 2nd paragraph have been obviated and thus, Applicant requests that the rejection of claims 1-7 and 13-16 be removed.

Claim Rejections Under 35 USC § 103

Claims 1-5 and 13-16 are rejected under 35 USC § 103(a) as being anticipated by JOHNSON '683 in view of JOLLIFFE; and

Claims 6-7 were rejected under 35 U.S.C. §103(a) as being obvious over JOHNSON/ JOLLIFFE combination in further view of Danneels et. al. U.S. Patent No. 6,272,472 B1 (hereinafter "DANNEELS").

The rejection of claims 1-5 and 13-16 under 35 USC § 103(a) based on JOHNSON, JOLLIFFE, and DANNEELS is respectfully traversed.

The JOHNSON reference is directed to a method of purchasing products from a supplier catalog, creating a catalog database of products listed within a plurality of supplier catalogs, wherein each product is displayed within an associated supplier catalog, and requisitioning an available product **based on a best price** from a selected supplier catalog. See Johnson col. 4, lines 35-41, "a catalog database

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36 comprised preferably of at least two vendor product catalogs. The catalogs, and hence catalog database 36, preferably include such information as part number, price, catalog number, vendor name or I.D., and vendor catalog number, **as well as textual information and images** of or relating to the catalog products." See also Johnson col. 5, lines 66-67 through col. 6, lines 1-3, "The data passed by interface 60 preferably comprise all or a subset of the following twelve fields: vendor name, vendor number, vendor part (catalog) number, product description, bid price, list price, keyword, page number, quantity, unit, catalog text, and catalog images.")

JOHNSON uses an interface to pass 12 fields from a supplier to the catalog database and then searches the 12 fields for products that match pre-defined catalog search criteria to form a purchase requisition. See JOHNSON col. 6, lines 5-22. The 12 fields comprise: "vendor name, vendor number, vendor part (catalog) number, product description, bid price, list price, keyword, page number, quantity, unit, catalog text, and catalog images." See JOHNSON col. 5, lines 65-67 through col. 6 lines 1-3.

The JOLLIFFE reference generally teaches the concept of designing vendor-neutral engineering systems, particularly involving electrical engineering systems that are part of an

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automobile. The JOLLIFFE reference further teaches a generic translation software that operates between two different Computer Aided Engineering (CAE) tools. See JOLLIFFE, col. 5, lines 27-31 ("In its simplest form, the system disclosed is thus a method for data exchange and communication between vendor independent tools and tools that do not necessarily speak the same language or have the same concepts.") Additionally JOLLIFFE uses a 2-dimensional CAD file for use in designing an optimal electrical system. See generally JOLLIFFE and FIGS. 1-14. JOLLIFFE also teaches a limited use of a CAE tool that is used to design a 3-D harness. See JOLLIFFE, col. 5, lines 5-7 ("There might also be additional tools (not shown) which perform full 3-D harness design").

The Danneels reference teaches a dynamic linking system that facilitates communications between three system components: a supplier server, a reseller server, and a purchaser client web browser. See DANNEELS col. 4, lines 22-23. DANNEELS enables a purchaser to select a reseller from a list of resellers supplied by the supplier server to purchase a desired item from a reseller that sells the associated desired item. Unlike the present invention, the JOHNSON and JOLLIFFE reference fails to teach, suggest or hint at the use of the very specific vendor neutral electrical system to "selectively us[e] said at least one transmitted computerized design file associated with the at least one component

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disposed within said product to create a three dimensional prototype of said product." Applicant's Application, Claim 1.

As mentioned on page 10 of the 12-09-2008 Examiner's Answer, "Johnson 683" does not directly disclose creating a three dimensional prototype of a product."

Thus, the JOHNSON reference fails to disclose use of a three dimensional image to produce a prototype of the product as defined in claim 1.

However, Examiner contends on page 10 of the 12-09-2008 Examiner's Answer that "However, Jolliffe teaches that in a vendor-neutral automobile system the concept of creating a three dimensional image in a CAE system for design products and components (col 5, line 65-col 5, line 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson 683" as taught by Jolliffe to include creating a three dimensional prototype of the component or product. Such a modification would have helped permit."

It appears that the last sentence above of Examiner's Answer is a fragment ending in "permit". Therefore, Applicant requests clarification of the reason for modification of Johnson 683 as taught by Jolliffe.

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It is well known in the automotive electrical arts that a 3-D harness design may be used to determine the relative loads, transients, and distances of the wires disposed within a wiring harness. Such a 3-D harness design as described in JOLLIFFE may be created using the method of the present invention. However, the same 3-D harness design tool could not create a three dimensional prototype of any product¹ as defined in the present invention using the JOLLIFFE method. "In keeping with the present invention, there is further provided a method for accommodating data interchange between multiple vendor-independent Computer Aided Engineering (CAE) tools. **The method is specifically directed for use in an integrated vehicle electrical design and analysis system.**" JOLLIFFE, col. 10, lines 21-26. Thus, the JOLLIFFE reference teaches away from using a general design method for designing an non-electrically related product as disclosed in the Applicant's invention.

¹ See *supra* ("product" as used within applicant's originally submitted application "means any tangible item which must be created or obtained and which meets certain needs or requirements of a business organization and/or certain customers of such a business organization." Applicant's Application, page 1, lines 23-27. See also, Applicant's Application, page 3, lines 15-22 "a method for designing and purchasing a product . . . which identifies potential sources of the product and/or of components which may be assembled to produce such a product while technically and economically evaluating each of the potentially sourced products and component combinations.").

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Additionally, such a 3-D wiring harness alone or in combination with other wiring harnesses cannot create a 3-dimensional prototype of a fully surfaced and textured automotive component or product. Therefore, a 3-D CAD file of a wiring harness cannot be combined with the template of the JOHNSON reference to render a 3-D "product" prototype as is disclosed in Applicant's invention.

Therefore, there is no motivation nor would it have been obvious to combine the JOHNSON reference with the JOLLIFFE reference to render applicant's invention.

Additionally, even if a motivation to combine the JOHNSON reference with the JOLLIFFE reference exists, the results of the combination of the two references of record would still not render the 3-dimensional product prototype design produced using Applicant's invention. For example, if the pre-defined fields of the catalog template taught in the JOHNSON reference, particularly the textual information and 2-dimensional catalog images, were able to be translated into a vendor-neutral language using the method of the JOLLIFFE reference, only 2-dimensional images or data relating to electrical systems could be used in accordance with the JOLLIFFE method and furthermore, the images could not be converted into a 3-D product prototype using the JOLLIFFE method. Conversely, using the method of the JOHNSON reference,

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data relating to a 3-D wiring harness of the JOLLIFFE invention would still be transmitted as 2-dimensional image using the catalog image template field of the JOHNSON invention. Therefore, the combination of JOLLIFFE AND JOHNSON would not have been obvious to render the claims of Applicant's Invention, mainly:

"creating an information template that is queried and dynamically configurable on the computer within the communications network for each of the plurality of suppliers wherein each of the information template specifies a product having at least one component disposed within the product;
searching each of the information templates selectively stored within a database for the specified at least one component disposed within the product;
causing a design file of said product to be created within the communications network by performing the steps of
transmitting at least one computerized design file associated with the at least one each component disposed within said product created from each of said identified suppliers from the plurality of suppliers to a purchaser, and
selectively using said at least one transmitted computerized design file associated with the at least one component disposed within said product to create a three dimensional prototype of said product."

Thus it would not be obvious to combine the teachings of the JOHNSON reference with the teachings of the JOLLIFFE reference to render the 3-D prototype design of the present invention.

Thus, Claim 1 is now believed to be patentably distinct from the prior art of record. Additionally, claims 1-7, and 17-18 which depend from claim 1 are also believed to be

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patentably distinct from the prior art of record and thus, present patentable subject matter.

Claim 13 has been amended to clearly define the information template associated with each supplier and with each product "wherein the dynamically configurable and searchable field is configured on the computer to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of said product associated with each of said plurality of suppliers and wherein the interrelationship attributes of said components further define the overall function of each of the several interconnected components."

Support for amending claim 13 with respect to interrelationship attributes is disclosed in Applicant's Application, page 6, lines 18-23; page 7, lines 10-19; page 8, lines 18-26 through page 9, lines 1-21.

Applicant, being his own lexicographer, see discussion of Phillips and claim interpretation, supra, hereby defines "interrelationship" to mean how each of the products or components disposed within the products spatially relate to one another, or similarly, how the item [i.e. product or component] relates to other items [i.e. products components]. See Applicant's Application, page 7, lines 10-14: "Step 18

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follows step 16, and in this step, . . . any **interrelationship attributes (i.e., attributes related to the interrelationship of the product to other products or components)** are identified." See also, Applicant's Application, page 6, lines 18-23 describing the interrelationship of two components used to form a product: "For instance, the needed gear assembly may require a pair of dissimilar gears which are coupled in a certain manner [i.e. "interrelationship between the pair of dissimilar gears"] in order to provide the desired coupling function. Therefore, in this step 16, the **basic tangible elements [i.e. "components"] which cooperatively form the product are identified.**"

Patents are written by and for skilled artisans, see Vivid Technologies v. American Signs, 200 F.3d 795, 804, 53 USPQ2nd 1295, see also S3 v. Nvidia, 259 F.3d 1354, 1371, 59 USPQ 2nd 1795, 1749-50. Thus, the definition and use of "interrelationship" with regard to automotive products or components is well known in the art.

In addition to descriptions of interrelationship in Applicant's Application, use of the term "interrelationship" can be found in U.S. Patent application No. 5, 380,978 entitled "Method and apparatus for assembly of car bodies and other 3-dimensional objects, filed on July 12, 1991 issued to PRYOR discussing the "interrelationship" of components being

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assembled in an automotive manufacturing environment "This is quite different than today's practice, where sub-assemblies are built up, even in other factories, hundreds of miles away, and one really has no knowledge of the **interrelationship** of the dimensions of the various pieces. One only "hopes" that it goes together." Col. 13, lines 33-37.

Thus, "interrelationship" can be interpreted as the physical location of structural relationship of one component or product to another. Therefore, claims 13-16 must be examined in light of the definitions provided by the applicant lexicographer in the specification as discussed supra.

Using applicant's definition of the term "interrelationship", no such template having a dynamically configurable and searchable field for defining **interrelationship attributes** is provided in either the JOHNSON or the JOLLIFFE reference.

Both the JOHNSON and the JOLLIFFE reference fail to disclose "a dynamically configurable and searchable field that is queried on the computer within the communications network wherein the dynamically configurable and searchable field is configured on the computer to specify to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of

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said product associated with each of said plurality of suppliers and wherein the interrelationship attributes of said components further define the overall function of each of the several interconnected components" as recited in amended claim 13. While the fields of the template taught in JOHNSON may have pre-defined but searchable fields, none of the pre-defined values within the fields define an interrelationship of the several interconnected components of the product identified.

With regard to the JOHNSON reference, the hit list consists of a list of product part descriptions and numbers and the textual information field as taught in the JOHNSON reference lists factual information and some physical specifications of the product or component as a whole, but fails to describe the interrelationship of the product with regard to another product, or of a component with regard to another component. See JOHNSON appendices. Additionally, no such template or fields are taught in the JOLLIFFE reference.

Additionally, in 12-09-2008 Examiner's Answer, page 7, the Examiner stated "Since Applicants did not seasonably traverse (or inadequately traversed) the Official Notice statement(s) as stated in the previous Office Action; the Official Notice statement (s) are taken to be admitted prior art. See MPEP 2144.03."

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The Official Notice statement to which Examiner was referring was first stated in the November 20, 2002 Office Action, paragraph 15, wherein Examiner rejected claim 5, and 13-15 based on JOHNSON:

"Official Notice that auto parts with part numbers are supplied from third party vendors . . . and selectively assembled in vehicles"

Applicant admits that that auto parts with part numbers are supplied from third party vendors . . . and selectively assembled in vehicles. However, Applicant traverses the interpretation of the Official notice to respectively extend beyond taking official notice of assemblies of components within vehicles, to include the use of a template having a dynamically configurable and searchable field configured on the computer to specify a plurality of interrelationship attributes related to the interrelationship of the several interconnected components of the product associated with each of said plurality of suppliers.

Thus, there since both JOHNSON and JOLLIFFE are silent with respect to describing interrelationship of the product with regard to another product, and the combination of the JOHNSON reference with the JOLLIFFE reference to render

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applicant's invention could not have been used to produce Applicant's Application.

With regard to claims 6-7, claims 6-7 were rejected under 35 U.S.C. §103(a) as being obvious over JOHNSON/ JOLLIFFE combination in further view of DANNEELS.

The DANNEELS reference fails to disclose, teach, or suggest a purchasing system that "selectively us[es] . . . at least one transmitted computerized design file associated with the at least one component disposed within said product to create a three dimensional prototype of said product" as disclosed in independent Claim 1, from which claims 6-7 depend. Additionally, as discussed supra with respect to the 103 rejections for claim 1, it would not have been obvious to combine the JOHNSON reference with the JOLLIFFE reference to render the claims of Applicant's invention as the JOLLIFFE reference teaches away from using a general design method for designing an non-electrically related product as disclosed in the Applicant's invention.

With regard to claim 17, claim 17 has been newly added to further define the product as being used in an automobile. Support for adding claim 17 is disclosed in Applicant's Application, page 1, lines 19-27.

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With regard to claim 18, claim 18 has been newly added to further define the product as having a plurality of interconnected disposed therewithin and wherein the interrelationship of the components are specified within the dynamically configurable information template. Support for adding claim 18 is disclosed in Applicant's Application, page 6, lines 21-26 ("the basic tangible elements [i.e. components] which cooperatively form the product are identified").

It is believed that claim 13 as amended is patentably distinct from the prior art of record. Additionally, the claims 14-16 which depend from claim 13 are also believed to be patentably distinct from the prior art of record.

Accordingly, Applicants respectfully submit that Claims 1 and 13 are allowable and that the rejection under 35 U.S.C. § 103(a) based on JOHNSON, JOLLIFFE, and DANNEELS be withdrawn.

Claims 2-7, and 17-18 depend from Claim 1 and are therefore allowable for the same reason that Claim 1 is allowable. Claims 14-16 depend on Claim 13 and are likewise allowable.

Independent Claim 1 has been amended to further define the invention. Therefore, Claim 1 is now believed to patentably define over the prior art relied upon by the Examiner.

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Additionally, Claims 5-7, and 17-18 which depend from Claim 1 are also believed to be patentable over the prior art relied upon by the Examiner for the same reasons that Claim 1 from which they depend is also patentable.

Independent Claim 13 has been amended to further define the invention. Therefore, Claim 13 is now believed to patentably define over the prior art relied upon by the Examiner. Additionally, Claims 14-16 which depends from Claim 13 are also believed to be patentable over the prior art relied upon by the Examiner for the same reasons that Claim 13 is also patentable.

The rejection of claims 1-7, and 13-16 under 35 USC § 103(a) based on obviousness is respectfully traversed. A reconsideration for allowance of these claims is respectfully requested of the Examiner.

Additional Remarks relating to the Examiner's Answer and to the 05-13-2008 OA

The 12-09-2008 Examiner's Answer was silent as to the following issues that were presented in the 5-13-2003 OA, wherein the Examiner additionally:

rejected claims 8-12 as being drawn to a nonelected invention; and

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approved the proposed substitute sheets of drawings filed on April 22, 2003 (part of Paper No. 6).

Restriction Requirement

Although, the Examiner's Answer was silent to the election requirement, the Examiner, on page 2, clause 2 of the May 13, 2003 office action (5-13-03 OA), requested cancellation of Claims 8-12 as they are drawn to a nonelected invention. Applicant elected claims 1-7 and 13-17. Claims 8-12 have been cancelled as the result of an earlier restriction requirement.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 8-12 in a divisional application.

Approval of the Drawings

Although, the Examiner's Answer was silent to Drawing Correction, the Examiner required on page 2, clause 3 of the 5-13-03 OA that a proper drawing correction or corrected drawings be submitted in a reply to the 5-13-03 OA to avoid abandonment of the application. Examiner approved the proposed substitute sheet of drawings filed on April 22, 2003 (part of Paper No. 6). Accordingly, entry of Applicant's proper corrected drawing sheet for FIG. 1 as required by

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Examiner previously submitted in Applicant's Response to the 5-13-03 OA is requested. No new matter was added to FIG. 1.

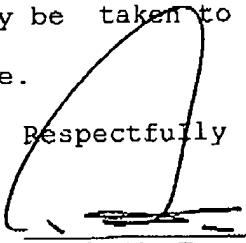
CONCLUSION

The foregoing amendments further clarified some of the features of the method for designing and purchasing a product. It is believed that the present invention as amended is novel and non-obvious over the references relied upon by the Examiner.

Based on the foregoing, the Applicant respectfully submits that all of the pending claims, i.e. claims 1-7, and 13-18 are now in condition for allowance. Such favorable action by the Examiner at an early date is respectfully solicited.

In the event that the present invention as claimed is not in condition for allowance for any reason, the Examiner is respectfully invited to call the Applicant's representative at his Bloomfield Hills, Michigan office at (248) 540-4040 such that necessary action may be taken to place the application in a condition for allowance.

Respectfully submitted,



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